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Peter B. Risi

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MACMILLAN SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA FIFTH FLOOR  
720 WATER STREET  
TOLEDO, OH 43604-1619

EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1772

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09/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## **DETAILED ACTION**

### ***Rejections Withdrawn***

1. Claims 27, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Okochi (EP: 1262534) made in the Office Action of 3/12/2007 has been withdrawn in view of the amendment filed on 7/11/2007.
2. Claims 27, 28, 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (6982107) made in the Office Action of 3/12/2007 has been withdrawn in view of the amendment filed on 7/11/2007.
3. Claims 28 and 36 are rejected under 35 U.S.C. 103(a) as being obvious over Hennen (6982107) in view of Dickmann (4325855) made in the Office Action of 3/12/2007 has been withdrawn in view of the amendment filed on 7/11/2007.
4. Claims 29, 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann and Rolf (6096333) made in the Office Action of 3/12/2007 has been withdrawn in view of the amendment filed on 7/11/2007.
5. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann, Rolf and Goodson (6783799) made in the Office Action of 3/12/2007 has been withdrawn in view of the amendment filed on 7/11/2007.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 27-38 and newly submitted claims 39-41 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 27-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27 and 39, the phrase “curable gelled” is found to be confusing and vague because it is not clear as to how can a gelled adhesive be not cured? It is understood that a “gelled” adhesive is directed to an adhesive that is different from a “gelable adhesive” as an adhesive is usually curable to a “gelled” state.

9. **Also, for examination purpose, the new claimed phrase “curable gelled adhesive” is interpreted to be “gelled adhesive”.**

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 27, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Okochi (EP: 1262534).

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At first, applicant is informed that because the provisional application fails to provide support for the instant independent claim 1, Okochi is a proper reference under 35 USC 102(b).

For claims 27, Okochi relates to an adhesive product comprising a backing strip of a release liner (paragraph-[0056]) and a gelled adhesive (paragraph-[0008]) on the backing strip.

The intended use phrases such as " **for adhering** wood pieces together", "the adhesive **when fully cured** and adhering the wood pieces together having an adhesive strength of at least about 8 Mpa as measured according to British Standard BS EN 205" 1991, Armex A", etc. have not been given any patentable weight because said phrase are not found to be of positive limitation.

For claim 37, the adhesive is in the form of a layer of the adhesive on the backing strip (abstract).

Regarding claim 38, the product is in the form of a tape (abstract).

12. A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 27, 28, 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (6982107).

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For claim 27, Hennen relates to an adhesive product comprising a backing strip of a release liner (col. 2, lines 1-5) and a gelled adhesive (col. 8, lines 58-63) on the backing strip.

The intended use phrases such as " **for adhering** wood pieces together", "the adhesive **when fully cured** and adhering the wood pieces together having an adhesive strength of at least about 8 Mpa as measured according to British Standard BS EN 205" 1991, Armex A", etc. have not been given any patentable weight because said phrase are not found to be of positive limitation.

For claim 28, the adhesive comprises an adhesive resin (such as, polyvinyl acetate) (col. 8, lines 1-11) and would inherently include a gelling agent as the adhesive is formed into a gelled film

For claim 37, the adhesive is in the form of a layer of the adhesive on the backing strip (abstract).

Regarding claim 38, the product is in the form of a tape (abstract).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 28, 36, 39 are rejected under 35 U.S.C. 103(a) as being obvious over Hennen (6982107) in view of Dickmann (4325855).

Hennen, as discussed above, fails to expressly teach that the adhesive comprises a gelling agent. Dickmann relates to an adhesive gel comprising an adhesive resin and a gelling agent (abstract). The adhesive includes polyvinyl acetate and polyvinyl alcohol (col. 2, lines 35-40), emulsion or dispersing agent (col. 3, lines 3-5) and ionic salt (col.3, lines 26-28). Therefore, it would have been obvious to one having ordinary skill in the art to utilize dickmann's teaching of using a gelling agent with the adhesive resin in the invention of Hennen with the motivation to provide for stabilizing the adhesive gel.

16. Claims 29, 32-35, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann and Rolf (6096333).

Hennen and Dickmann, as discussed above, fails to teach that the gelling agent is a gelling colloid. Rolf discloses a gelled adhesive comprising polyvinyl acetate adhesive (col. 5, lines 25-27), gel forming poymer such as listed in lines 12-20, and a humectant such as glycol (col. 5, lines 22-23), which would function as a coalescing colvent.

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Rolf's teaching of using gelling colloid in the invention of Hennen with the motivation to provide a gel with the adhesive.

17. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann, Rolf and Goodson (6783799).

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Hennen, Dickmann and Rolf, as discussed above, fails to teach that the gelling agent comprises colloidal silica and an electrolyte. Goodson discloses adding mixtures of phosphate salt and colloidal silica to an adhesive composition increases the adhesion capacity of the composition (col. 9, lines 43-53). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Goodson's teaching of using colloidal silica and phosphate salt in the adhesive composition in the invention of Dickmann with the motivation to increase the adhesive capacity of the composition.

### ***Response to Arguments***

18. Applicant's arguments filed 7/11/2007 have been fully considered but they are not persuasive.

Applicant argues that *the adhesive strength of the cured adhesive is a positive limitation of an important property of the adhesive product. Also, the British Standard included in the claims is a standard test for the adhesive strength of a cured adhesive bonding together wood materials. Surely the adhesive strength property should be given patentable weight as a positive limitation.* These are not found to be convincing because it is noted that the phrase "when fully cured" is directed to an intended future use condition of the claimed adhesive and hence, is not a positive limitation. Also, the claims are directed to an adhesive product and not wood pieces adhered together with said claimed adhesive.

In response to applicant's arguments that *the claims state that that the adhesive when cured has an adhesive strength of at least about 8 Mpa. In contrast, the Okochi adhesive must have a relatively low adhesive strength so that the adhesive sheet can*

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*be removed after it is applied. Okochi discloses a removable pressure sensitive adhesive that has a gel fraction of at least 70% when cured, applicant is informed that the adhesive strength is directed to an intended use condition as explained hereinbefore.*

Applicant also argues that *the cited patents neither teach nor suggest an adhesive product that when cured and adhering wood pieces together has an adhesive strength of at least about 8 Mpa as measured according to the British Standard test for the adhesive strength of a cured adhesive bonding together wood materials. For example, Hennen discusses adhering to plastics, not to wood pieces, and particularly not adhering two wood pieces together. Although painting is mentioned in Hennen, it is in relation to painting a plastic auto part, not a wood piece.* This is not deemed to be persuasive because the hereinabove provided explanation apply a fortiori herein, in that, the claims are directed to a adhesive product and not its combination with said wood pieces.

Regarding applicant's argument that, *in particular, the cited patents do not suggest an adhesive product comprising a backing strip of release material and a gelled adhesive on the backing strip to adhere two wood pieces together,* applicant is directed to the fact that the underlined phrase is directed to an intended use of the claimed product. For example, if the claimed product comprises a backing strip of release material, then how are the two wood pieces adhered together by said adhesive product. It is also noted that the claims are directed to "for adhering wood pieces" and not "two wood pieces" as alleged.

Applicant's argument that *there is no suggestion that such a product could be made suitable for use as a wood adhesive for adhering wood pieces together* is found to be directed to an intended use of the claimed product because the underlined phrase

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"suitable for use" is directed to an intended use of the claimed product.

Therefore, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record.

### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

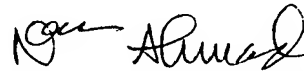
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad 9/27/07  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
September 27, 2007.